

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBIN B. GILSON

Appeal No. 2001-0840
Application No. 08/896,882

HEARD: November 20, 2002

Before PAK, JEFFREY T. SMITH, and PAWLIKOWSKI, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 24, which are all the claims pending in the above-identified application.

Claims 1, 4 and 11 are representative of the subject matter on appeal and read as follows:

1. A final vulcanized rubber composition, that is not a thermoplastic, for use in making clothing and fashion accessories having a tensile strength of 2000-2350 psi, and elongation of 325-425%, and a Shore A hardness of 45-75 and comprising, before vulcanization of said rubber composition, about 30%-70% (by weight) devulcanized, recycled rubber.
4. A method for using a final, vulcanized rubber composition, that is not a thermoplastic, to make clothing and fashion accessories comprising the steps of:

providing a rubber composition consisting essentially of, about 30-70% devulcanized, recycled rubber by weight, and the remainder comprising natural or synthetic rubber, carbon black, process oil, silica, activators, process aids, accelerators and sulfur;

sheeting said rubber composition;

vulcanizing said rubber composition;

cutting said rubber composition after vulcanizing; and

securing the rubber composition

11. A personal article comprising a final, vulcanized rubber composition, that is not a thermoplastic, said rubber composition before vulcanization consisting essentially of about 30-70% devulcanized, recycled rubber by weight, and the remainder comprising natural or synthetic rubber, carbon black, process oil, silica, activators, process aids, accelerators and sulfur.

Claims 1 through 24 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking written descriptive support for the subject matter presently claimed¹. Claims 1 through 24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which regards as his invention.

We reverse.

We turn first to the examiner's rejection of 1 through 24 under 35 U.S.C. § 112, first paragraph, as lacking written descriptive support for the subject matter presently claimed.

According to the examiner (Answer, page 4), the claim language "that is not a thermoplastic" is not described in the application disclosure as originally filed. Although the criticized claim language is

¹ The examiner has withdrawn the § 102(b) rejection of claims 1 through 24 set forth in the final Office action dated December 14, 1999. See the Answer, Page 3.

not described in *ipsis verbis* in the application disclosure as originally filed, such is not required by Section 112, first paragraph. As the court stated in *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983):

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claimed language. (citations omitted)

To make this determination, it is important to evaluate whether a new concept is introduced by the claim language in question in violation of Section 112, first paragraph. *In re Anderson*, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Based on the facts of the present case, we concur with the appellant that the application disclosure as originally filed, when considered in its entirety, reasonably conveys to one of ordinary skill in the art the concept of forming and using a non-thermoplastic vulcanized rubber composition. As stated by the appellant (Brief, page 6), the specification sets forth a rubber composition which has been “vulcanized” to “transform a weak thermoplastic mass...into a strong, elastic, tough rubber.” This description is consistent with the definition for “vulcanization” as set forth at page 625 of *Grant & Hackh’s Chemical Dictionary*, fifth edition and at page 12 of *Polymer Chemistry: An Introduction* by Seymour et al., Marcel Dekker, Inc., 1981 (attached herewith). Vulcanization

involves cross-linking which produces a non-thermoplastic material². *Id.* We find no evidence to the contrary proffered by the examiner. Accordingly, we reverse this rejection.

We turn next to the examiner's rejection of claims 1 through 24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which regards as his invention. The purpose of the second paragraph of Section 112 is to basically insure, with a **reasonable** degree of particularity, an **adequate** notification of the metes and bounds of what is being claimed. *See In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). As the court stated in *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of Section 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a **reasonable** degree of precision and particularity. It is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Emphasis ours; footnote omitted.]

Here, the examiner criticizes the use of the terminology "that is not a thermoplastic" since it is said to be inconsistent with the claimed elongation property, i.e., "elongation of 325-425%". The examiner, however, does not indicate that the scope of the claim language cannot be ascertained.

² While thermoplastic is defined as "a linear polymer which may be softened by heat and cooled in a reversible physical process," thermoset plastic (non-thermoplastic) is defined as "a network polymer usually obtained by cross linking a linear polymer." See page 12 of *Polymer Chemistry: An Introduction* by Seymour et al., Marcel Dekker, Inc., 1981.

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Nor does the examiner provide any evidence to show that the phrases in question are contradictory. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444 (the examiner bears the initial burden of establishing a *prima facie* case of unpatentability). Under these circumstances, we do not believe that it can seriously be contended that the artisan would not understand the metes and bounds of what is being claimed. Accordingly, we reverse this rejection as well.

In view of the foregoing, we reverse the examiner's decision rejecting claims 1 through 24 under 35 U.S.C. § 112, first and second paragraphs.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY T. SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
BEVERLY A. PAWLIKOWSKI)	
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Application No. 08/896,882

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Letty

JUDGE PAK

APPEAL NO. 2001-0840

APPLICATION NO. 08/896,882

APJ PAK

APJ JEFFREY T. SMITH

APJ PAWLIKOWSKI

DECISION: **REVERSED**

PREPARED: Sep 12, 2003

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK